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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,476	09/28/2000	Michihiro Ota	80376	8514

24628 7590 10/28/2004

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EXAMINER
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BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/672,476

Applicant(s)

OTA ET AL.

Examiner

Igor Borissov

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*W*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 26-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

Amendment received on 7/30/2004 is acknowledged and entered. Claims 1-25 have been canceled. New claims 26-45 have been added. Claims 26-45 are currently pending in the application.

### ***Claim Objections***

Claims 31, 32, 41, 42, 46 and 47 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims 31, 32, 41, 42, 46 and 47 have not been further treated on the merits.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 26 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton et al. (US 6,292,786) in view of Resnick et al. (US 6,185,545) and further in view of Hoffberg et al. (US 5,901,246).**

Deaton et al. teach a method and system for generating incentives based on substantially real-time product purchase information, comprising:

**As per claim 26 and 36,**

- presenting point information issued for promotion of sale of merchandise to a user at the time of merchandise sale (column 2, lines 15-36; column 4, lines 15-36; column 10, lines 26-31);

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- transmitting to a center device said point information together with identification information for said user (column 2, lines 15-36; column 4, lines 15-36; column 10, lines 26-31);

- receiving at said center device said transmitted information (column 2, lines 15-36; column 4, lines 15-36; column 10, lines 26-31);

- totaling and managing at said center device said transmitted information (column 2, lines 15-36; column 4, lines 15-36; column 10, lines 26-31);

- offering a prescribed service to said user corresponding to the points (column 2, lines 15-36; column 4, lines 15-36; column 10, lines 26-31);

- wherein said point information comprises a module code related to said point issuing device (column 4, lines 15-36).

Deaton et al. does not specifically teach: that the point of said merchandise sales includes a *vending machine*; that said transmitting to a center device is conducted via a *portable terminal carried by a user*, and *encrypting of a secret code* related to said points.

Resnick et al. teach a method and system for making payments for the purchase of goods of services at point-of-sale locations, wherein a point-of-sale is a vending machine (column 3, lines 33-36; column 10, lines 1-2).

Hoffberg et al. teach a method and system for man-machine interface incorporating adaptive pattern recognition based control system, wherein financial information transmitted over the network is encrypted prior to presentation to the user (Fig. 25; column 1, lines 14-24; column 33, lines 12-17; column 37, lines 59-67; column 60, line 51 through column 62, line 32); and wherein the presentation of said information is performed by inputting said information to a communication equipment of said user, by means of communication between said point issuing device and said communication equipment, wherein said communication equipment comprises a portable telephone set carried by said user (column 110, line 46-58).

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deaton et al. to include that said point-of-sale is a vending machine, as disclosed in Resnick et al, because it would advantageously allow to install said system in the locations where the assistance of a sales-representative or a cashier is not feasible or desirable. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deaton et al. in view of Resnick et al. to include encrypting of information related to said points; and provide portable terminal to a user, as disclosed in Hoffberg et al, because it would advantageously enhance the security of the system; and allow the user to perform said operations in various locations.

**As per claims 28 and 38,** Deaton et al. teach said method and system, wherein the presentation of said point information is performed by printing out said point information on a prescribed form from said point issuing device (column 6, lines 27-37; column 16, lines 16-20).

**As per claims 29-30 and 40-41,** Hoffberg et al. teach said method and system, wherein the presentation of said point information is performed by inputting said point information to a communication equipment of said user, by means of communication between said point issuing device and said communication equipment, wherein said communication equipment comprises a portable telephone set carried by said user (column 110, line 46-58). The motivation to combine Deaton et al. in view of Resnick et al. and Hoffberg et al. would be to allow the user to perform said operations in various locations.

**As per claims 33 and 43,** Deaton et al. teach said method and system wherein said center device comprises an equipment database to store and manage a state of at least one of said point issuing means and the equipment performing sales of said merchandise in which said point issuing means is provided, in correspondence with said module code (column 4, lines 15-36).

**As per claims 34-35 and 44-45**, Deaton et al. teach said method and system, wherein said center device permits the user to read point information stored and managed for said user in response to a request from said user (column 5, lines 12-29).

**Claims 27 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton et al. in view of Resnick et al., further in view of Hoffberg et al. and further in view of Nakajima et al. 9US 4,636,963).**

**As per claims 27 and 37**, Deaton et al. in view of Resnick et al., further in view of Hoffberg et al. teach all the limitations of claims 27 and 37, except specifically teaching: *setting a display unit based on a return signal issued by operation of a return lever of said vending machine; setting a timer for counting a predetermined time based on the return signal; displaying point information based on a money collecting signal; and erasing the display of the point information based on when the return signal is reissued by re-operation of the return lever or when the timer times out.*

Nakajima et al. Teaches a control system and method for an automatic vending machine, including a switch (return lever), a timer and a display; wherein, in response to activation of said switch (return lever), information related to gross sales and accumulated discounts (points) is displayed; and wherein said vending machine is reset into the original mode if said switch not being actuated for a predetermined time period (column 7, lines 4-34; column 13, line 44 – column 14, line 43).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deaton et al. in view of Resnick et al., further in view of Hoffberg et al. to include that in response to activation of said switch (return lever), information related to gross sales and accumulated discounts (points) is displayed; and wherein said vending machine is reset into the original mode if said switch not being actuated for a predetermined time period, as disclosed in Nakajima et al, because it would advantageously provide a customer with information related to accumulated discounts (points) during a transaction, and would preserve the confidentiality of said

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information by clearing up the display after the predetermined time period if said customer forgets to cancel the transaction.

### ***Response to Arguments***

Applicant's arguments filed 07/30/2004 have been fully considered but they are not persuasive.

The Applicant argues that the only reference Resnick makes to a vending machine is column 10, lines 1-2, which is in the claims, and that there is not teaching or suggestion of a vending machine in the specification, and, accordingly, Resnick cannot enable a written description of a use of a vending machine in his invention, and cannot be the basis for a rejection.

In response to this argument the examiner stipulates, that as per *absence of teaching of the inventive feature in Resnick's specification*, Resnick, in fact, does teach a vending machine in the specification. Specifically, column 3, lines 33-36 teaches: "A point of sale for present purposes can also be an automate teller machine (ATM), a kiosk, touch-screen or other data terminal as further described herein at any location accessible to users."; which meets the description of a vending machine.

Furthermore, as to *non-enablement of Resnick*, it is noted that a prior art patent cannot be presumed as non-enabling or otherwise invalid as to any of the claimed features. There is no evidence that a re-examination on the patent was ever conducted in which enablement was raised as an issue or sustained as an issue. Accordingly, a presumption of non-enablement in such valid patent cannot be accepted or even considered.

Furthermore, the examiner points out that the issue of *enablement* is moot, since the real issue under consideration is *obviousness, not enablement*. The prior art teachings are considered for their teachings of obvious features.

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In response to applicant's argument that the prior art does not teach: *transmitting to a center device the point information presented by a point issuing device by the operation of a user using a portable terminal, together with a user identification information*, the examiner points out that Deaton teaches: presenting point information issued for promotion of sale of merchandise to a user at the time of merchandise sale; and transmitting to a center device said point information together with identification information for said user (column 2, lines 15-36; column 4, lines 15-36; column 10, lines 26-31). Hoffberg was applied to show the use of a portable telephone set carried by said user for communication of said information (column 110, line 46-58).

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

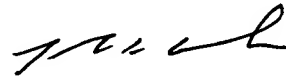
or faxed to:

**(703) 872-9306** [Official communications; including After Final  
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

IB

10/19/2004



JOHN G. WEISS  
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